

**REMARKS**

Claims 1-28 are the pending claims. Claim 1 is written in independent form. No claims are amended in response to the outstanding Office Action.

**I. Claim Rejections under 35 USC §102**

Claims 1, 7-18, 20, 22, 25 and 26 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,556,848 to Leyden et al. (Leyden). The rejection is respectfully traversed.

Leyden discloses a security apparatus for monitoring an article to prevent unauthorized removal of the article. In Leyden, the security apparatus 60 includes a housing 68 that contains all of the electrical components of the apparatus 60. The housing 68 is made of a rigid material, such as a hard plastic (col. 6, lines 8-11). The apparatus 60 also includes a body 62 made of a material that can be configured into a plurality of shapes and maintain itself in the plurality of different shapes. Once the material is conformed to a particular article, the body will not spring back to its undeformed shape. As a result, a positive bond between the body 62 and the article 88 being protected can be maintained without fear of peeling off by reason of its own reconfiguration (col. 2, line 61-col. 3, line 4; col. 6, lines 46).

Thus, in contrast to the claimed retaining component that includes an “elastically deformable material,” the body 62 is not elastic. Rather, as clearly described in Leyden, the body 62 “once conformed...will not spring back to its undeformed state.” Thus, it appears the Examiner may confusing the plasticity of Leyden with the elasticity of the present invention.

For example, Leyden clearly describes the “conformable part of the body” 62 as being “made from a material that can be reconfigured into a plurality of shapes and maintains itself in the plurality of different shapes” (see col. 6, lines 35-39 and claim 1 of Leyden). In contrast to the “plastic” characteristics of

Leyden, the device of the present invention, and recited in the claims, is an “elastically deformable material.”

It is alleged in the Response to Arguments section of the present Office Action that the claimed feature of being an “elastically deformable material” is met by the prior art and that the “broadest reasonable interpretation” is “capable for change/expansion/contraction, not rigid or constructed.” However, the Examiner provides no authority for this “broadest reasonable definition.” Moreover, the alleged definition is in conflict with the description of an elastically deformable material as that term is used in the specification and well-known in the art.

Applicant respectfully reminds the Examiner that when interpreting claims during examination claims are not to be given their “broadest reasonable definition” as alleged by the Examiner. Rather, “claims yet unpatented are to be given their broadest reasonable interpretation consistent with the specification during an examination of a patent application” (*Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005), *In re Prater*, 415, F. 2d 1493 (1969)). This standard is also provided as the standard for claim interpretation under MPEP §2111 which recites that “during patent examination the pending claims must be given the broadest reasonable interpretation consistent with the specification.”

As the Examiner has not interpreted the claims in accordance with the MPEP and has not provided a source for the definition used by the Examiner, the rejection of the claims is improper.

Further, from the Examiner’s interpretation of the term “elasticity” it appears that the Examiner fails to appreciate that “elasticity” has a well-known definition in the art that denotes a special type of deformation, rather than the mere ability to be deformed under the effect of external forces. For example, the Encyclopedia Britannica describes elasticity as “enabling a solid to return to

its original shape after the load has been removed.” In contrast, the Encyclopedia Britanica describes plasticity as “enabling a solid, under the action of external forces, to undergo permanent deformation without rupture” (as in Leyden).

Thus, when properly interpreted, Leyden fails to disclose an “elastically deformable material.” Rather, as discussed, Leyden merely describes the body being “made from a material that can be reconfigured into a plurality of shapes and maintains itself in the plurality of different shapes” (i.e., plastic).

Because of this well-known difference between elastic materials and plastic materials, Leyden actually teaches away from the use of the claimed “elastically deformable material” because every embodiment of Leyden is related to a plastically deformable material that does not have a tendency to peel off (col. 6, lines 43-46). For example, Leyden recites the use of a thermal setting rubber that will retain its shape, rather than “a conventional plastic flexible material that, while reconfigurable, tends to reassume its undeformed state” (col. 6, lines 35-43).

Regarding claim 7, it is alleged in the Office Action that Leyden discloses “the first retaining area and the second retaining area include the same material.” However, Leyden recites that the alleged first retaining area (housing 68) is made of a hard plastic to house the electrical components of the security apparatus 60. The alleged second retaining area of Leyden (body 62) is a thermal setting rubber. Thus, in contrast to the subject matter of claim 7, the first and second retaining areas of Leyden do not include the same material.

It is alleged in the Response to Arguments section of the present Office Action that the “first retaining area is the top area of apparatus 60 that is of the material 62, and the second retaining area is the bottom are of apparatus

60 that is of the material 62.” However, claim 1 recites that “the first retaining area” is the area for fastening the retaining component to a fastening component. Therefore, the first retaining area of Leyden must be the area 68 (housing) that houses the cord 74. As the housing 68 is clearly described in Leyden as being of a material different from the body 62, Leyden fails to disclose or suggest the features of claim 7.

As Leyden fails to disclose or suggest each and every feature of the rejected claims, withdrawal of the rejection is respectfully requested.

## **II. Claim Rejections under 35 USC §103**

Claims 2, 3, 5 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leyden in view of US Patent 6,268,795 to Hadfield. The rejection is respectfully traversed.

Claims 2, 3, 5 and 23 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein.

Moreover, Hadfield relates to a security tag for use in preventing theft of an article and does not overcome the deficiencies of Leyden. Therefore, the combination of references fails to disclose or suggest all of the features of the rejected claims. As the combination of references fails to render the rejected claims obvious, withdrawal of the rejection is respectfully requested.

Claims 4 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leyden in view of US Patent 6,436,527 to Zimmerman. The rejection is respectfully traversed.

Claims 4 and 6 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein.

Moreover, Zimmerman relates to a self-adhesive and re-detachable stencilling tape for use in painting or varnishing. Thus, Zimmerman fails to overcome the deficiencies of Leyden. As the combination of references fails to render the rejected claims obvious, withdrawal of the rejection is respectfully requested.

Claims 19 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leyden in view of US Patent 5,964,353 to Hamlin. The rejection is respectfully traversed.

Claims 19 and 21 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein.

Moreover, Hamlin relates to an energy absorbing carrier tape. Thus, Hamlin fails to overcome the deficiencies of Leyden. As the combination of references fails to render the rejected claims obvious, withdrawal of the rejection is respectfully requested.

Claims 24, 27 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Leyden in view of US Patent 5,433,391 to Jagger. The rejection is respectfully traversed.

Claims 24, 27 and 28 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein.

Moreover, Jagger relates to a cereal milling machine that grinds stock stored in a hopper using grinding rolls. Thus, Jagger fails to overcome the deficiencies of Leyden. Moreover, one of ordinary skill in the art would not seek to modify the security apparatus of Leyden with the teachings of a cereal

milling machine. As the combination of references fails to render the rejected claims obvious, withdrawal of the rejection is respectfully requested.

**CONCLUSION**

In view of the above remarks and amendments, the Applicant respectfully submits that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick, 41,018, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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